

REMARKS/ARGUMENTS

This is a Response to the Office Action mailed October 31, 2005, in which a three (3) month Shortened Statutory Period for Response has been set, due to expire January 31, 2006. Thirty-one (31) claims, including three (3) independent claims, were paid for in the application. Claims 1-6, 10-15, 18-19, 21 and 27-31 are currently amended. New claims 32-38 have been added. No new matter has been added to the application. Enclosed is our check to cover the fee for a one-month extension of time, to February 28, 2006, as well as the fee for additional claims due by way of this Amendment. The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. Claims 1-38 are pending.

Objections

The Examiner rejected claims 21 and 31 because both claims are directed to an apparatus for use with a device, stating that "the device is not defined" (page 2, paragraph 4a). Applicants respectfully traverse. Applicants respectfully submit that the specification discloses exemplary embodiments of devices with which the claimed apparatus may be operated. For example, the specification states that the apparatus may operate with "handheld devices, multiprocessor systems, microprocessor-based or programmable consumer electronics, network PCs, minicomputers, mainframe computers, and the like" (page 4, line 27 – page 5, line 1). Furthermore, Fig. 7 illustrates an embodiment configured to operate in conjunction with a vehicle (*i.e.*, the apparatus is configured to operate with the vehicle by detecting motion of the vehicle). Applicants submit that the specification adequately supports the claims. In other words, the claimed apparatus may be used with any device that is susceptible to motion. Applicants respectfully submit that since the specification discloses that the apparatus is configured to be used with various exemplary devices (*i.e.*, computing and non-computing devices) that are susceptible to motion, the claims are adequately supported for use with any such device. Applicants respectfully request that the Examiner withdraw the objections to claims 21 and 31.

Additionally, the Examiner objected to claims 27-30 because of informalities. In response, Applicants have amended claims 27-30 to correct the informalities.

Furthermore, the Examiner objected to claims 22-30 because of their dependency on claim 21. Based at least upon the above discussion in conjunction with claim 21 and the amendments to claims 27-30, Applicants submit that claims 22-30 are allowable, and respectfully request that the objections to claims 22-30 be withdrawn.

Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-6, 21 and 31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which the Applicant regards as his invention. Specifically, the Examiner contends that the phrase “frequently accessed” is a relative term which renders the claims indefinite. In response, Applicants have eliminated the phrase “frequently accessed” from claims 1-6, 21 and 31. Applicants submit that claims 1-6, 21 and 31, as amended, particularly point out and distinctly claim the subject matter which the Applicants regard as the invention, and respectfully request that the rejection of claims 1-6, 21 and 31 be withdrawn.

The Examiner rejected claims 7-20 and 22-30 because of their dependency on claims 1 and 21, respectively. Based at least upon the amendments to claims 1 and 21, Applicants submit that claims 7-20 and 22-30 are no longer indefinite, and request that the rejection of claims 7-20 and 22-30 be withdrawn.

Rejections Under 35 U.S.C. § 102(e)

The Examiner rejected claims 21, 22, 24, 26, 29 and 31 under 35 U.S.C. § 102(e) as being anticipated by *Kung* et al. (U.S. Patent Application Publication No. 2004/0078514) (hereinafter referred to as “*Kung*”). Applicants respectfully traverse.

The disclosed embodiment of the invention will now be discussed in comparison to the applied reference. Of course, the discussion of the disclosed embodiment, and the discussion of the differences between the disclosed embodiment and the subject matter described in the applied reference, do not define the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner to appreciate important claim distinctions discussed thereafter.

Amended claim 21 recites “[a]n apparatus for use with a device, the apparatus comprising: at least one solid-state memory; at least one spinning media memory; and a

controller configured to transfer data between the spinning media memory and the solid-state memory when the **device is not in motion**, and to not transfer data between the spinning media memory and the solid-state memory when the device is in motion.” (Emphasis added). The Examiner states that *Kung* discloses a controller consisting of micro-controller 22, firmware 23, and device driver program 11 (Fig. 2). The Examiner equates *Kung*’s flash memory card 5 with the solid-state memory of the present invention and *Kung*’s data storage device 13 with the spinning media memory of the present invention. The Examiner states that the *Kung*’s micro-controller 22 detects insertion of the flash memory card 5, and upon detection, files are copied from the flash memory card 5 to the data storage device 13. The Examiner contends that *Kung*’s file copying process anticipates the invention as claimed since the copying of files occurs when the flash memory card 5 is not in motion.

First, Applicants’ apparatus transfers data when “the device” is not in motion. As claimed, neither the spinning media memory, the solid-state memory, the controller (*i.e.*, the elements of the claimed apparatus), nor any combination of these elements is “the device.” However, the Examiner points to non-motion of the flash memory card 5 (*i.e.*, an alleged element of the claimed apparatus) as instigating the file copying process. In contrast, the apparatus as claimed transfers data when “the device” is not in motion, not when one of the elements of the apparatus is not in motion as contended by the Examiner.

Second, *Kung* simply does **not** disclose a system or method of copying files when a device or a component of the system is not in motion. Motion or lack of motion is not a disclosed feature of *Kung*’s system. *Kung* states, page 1, paragraph 10, “an automatically initiated task (upon media insertion) just requires a device driver that launches the application upon **media detection**.” (Emphasis added). That is, *Kung*’s disclosed method of copying files is not based upon motion, lack of motion, or detection of motion, but instead upon detection of a media card when inserted into an electrical connector. *Kung* states, “[t]he microcontroller 22 of the reader 2 has the ability to detect the insertion of flash memory card(s) 5” (page 2, paragraph 23). *Kung* does not disclose a system or method of copying files when a device is not in motion, but instead discloses a system that copies files when a memory card 5 is inserted into a connector 24 and electronically detected. In fact, it is reasonably clear that files would be copied from the flash memory card 5 to the data storage unit 13 even if *Kung*’s entire system were in motion.

Therefore, based at least upon the above remarks, Applicants respectfully submit that *Kung* does not anticipate amended claim 21, and request that claim 21 be allowed.

With regard to amended claim 31, the Examiner states arguments similar to those made in conjunction with claim 21. Based at least upon the above remarks made in conjunction with claim 21, Applicants submit that *Kung* does not anticipate amended claim 31, and request that claim 31 be allowed.

With respect to claim 22, the Examiner contends that since *Kung*'s microcontroller is able to detect insertion of the flash memory card, it is able to detect that the flash memory card is no longer in motion. Furthermore, the Examiner equates the flash memory card to the claimed device (page 4, paragraph 12). However, as discussed above in conjunction with claim 21, the device and solid-state memory are two different elements. As claimed, data is transferred between the spinning media memory and the solid-state device when "the device" is not in motion. There is no claim limitation to the motion of the solid-state device (*i.e.*, to the flash card memory). Furthermore, claim 22 recites "a motion sensor coupled to provide motion information to the controller." *Kung* does not disclose either a motion sensor coupled to the controller or any other device that provides "motion information" to the controller as claimed. Claim 22 depends directly from claim 21. Based at least upon the above remarks and the remarks made in conjunction with claim 21, Applicants respectfully submit that claim 22 is not anticipated by *Kung*, and request that claim 22 be allowed.

Claims 23-30 depend directly from claim 21. Applicants submit that claims 23-30 are allowable based at least on the same reasons given above in conjunction with claim 21, and request that claims 23-30 be allowed.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over *Kung* in view of *Stobbs et al.* (U.S. Patent Application Publication No. 2004/0039871) (hereinafter referred to as "*Stobbs*"). Applicants respectfully traverse.

Claim 30 depends directly from claim 21. Applicants submit that *Stobbs* does not remedy the deficiencies of *Kung* as discussed above in conjunction with claim 21. Applicants respectfully submit that claim 30 is not obvious over *Kung* in view of *Stobbs*, and request that claim 30 be allowed.

Conclusion

Applicants thank the Examiner for indicating the allowable subject matter of claims 1-20, 23, 25 and 27-28. Overall, the cited references do not singly, or in any motivated combination, teach or suggest the claimed features of the embodiments recited in independent claims 1, 21 and 31, and thus such claims are allowable. Because the remaining claims depend from the allowable independent claims, and also because they include additional limitations, such claims are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In light of the above amendments and remarks, Applicants respectfully submit that all pending claims are allowable. Applicants, therefore, respectfully request that the Examiner reconsider this application and timely allow all pending claims. Examiner is encouraged to contact Mr. Abramonte by telephone to discuss the above and any other distinctions between the claims and the applied references, if desired. If the Examiner notes any informalities in the claims, he is encouraged to contact Mr. Abramonte by telephone to expediently correct such informalities.

Respectfully submitted,

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